

Applicant : Therese F. Steiger et al.  
Serial No. : 10/710,924  
Filed : August 12, 2004  
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Attorney's Docket No.: 13213-107001

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### REMARKS

Claims 27, 32, 33, and 40 have been amended to correct a number of typographical errors. No substantive amendments have been made to independent claims 23 and 40. No new claims have been added or canceled. Accordingly, claims 23-44 remain pending in this application.

### Allowable Subject Matter

The Office Action indicated that dependent claims 38-39 and 44 would be allowable if rewritten into independent form. Applicants recognize the patentability of the subject matter described in claims 38-39 and 44, and Applicants reserve the opportunity to rewrite one or more of these claims into independent form at a later time.

### Correction of Informalities

Claims 27, 32, 33, and 40 have been amended to correct a number of typographical errors that were identified in the Office Action. No new matter has been added by these amendments. Applicants respectfully request that the claim objections be withdrawn.

### Claims 23-37

Independent claim 23 and particular dependent claims were rejected under 35 U.S.C. § 103 as being unpatentable over Abelarde (U.S. Patent No. 7,017,292) in view of Malino (U.S. Patent No. 5,799,423) and in further view of Tate (U.S. Patent No. 5,996,116). Applicants respectfully submit that, even if there was a suggestion to combine these references, the proposed combination fails to teach all elements of independent claim 23 (as required by MPEP § 2143.03).

Unlike independent claim 23, Abelarde fails to describe a fabric article "generally in the shape of a symbol associated with a holiday." Instead, Abelarde describes that a simple, rectangular substrate 102 can be cut from a sheet material. Abelarde does not describe that the rectangular substrate 102 is a shape associated with a holiday, but merely describes that the

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rectangular substrate 102 has a front surface 102a on which a design portion 104 can be "printed or otherwise marked" (e.g., a tree design 112 is printed on the rectangular surface 102a). (See Abelarde, col. 2, lines 63-67; FIGS. 1 and 4; *see also* FIGS. 5-6 (showing additional versions of the rectangular substrates 202 and 302)).

Malino and Tate are lacking for at least the same reasons. Malino fails to describe a fabric article "generally in the shape of a symbol associated with a holiday." Rather, Malino describes a rectangular body portion 22 made of non-ferromagnetic material (e.g., paper or cardboard) for display against a metal surface (e.g., against a refrigerator door). (See Malino, col. 3, lines 1-13; FIGS. 1-2.) Tate is a non-analogous reference that merely discloses an article of "golf clothing" having a magnetic material which is "concealed from view." (See Tate, col. 2, lines 6-29.)

Accordingly, even if there was a suggestion in the prior art to combine Abelarde (which incorporates Malino) and Tate, the proposed combination would fail to teach or suggest all elements of independent claim 23. Thus, the Office Action has failed to set forth a *prima facie* case of obviousness as required under MPEP § 2143.03. Applicants respectfully submit that independent claim 23 and associated dependent claims 24-37 are patentable over the prior art of record. Prompt allowance of claims 23-39 is respectfully requested.

#### Claims 40-43

Independent claim 40 and associated dependent claims 41-43 were rejected under 35 U.S.C. § 103 as being unpatentable over Abelarde in view of Tate and in further view of Malino. Applicants respectfully submit that, even if there was a suggestion to combine these references, the proposed combination fails to teach all elements of independent claim 40 (as required by MPEP § 2143.03).

First, similar to the reasons described above, Abelarde, Tate, and Malino fail to describe a fabric article "generally in the shape of a Christmas tree associated with a Christmas holiday." Instead, Abelarde describes that a simple, rectangular substrate 102 that has a front surface 102a on which a design portion 104 can be "printed or otherwise marked." (See Abelarde, col. 2, lines

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63-67; FIGS. 1 and 4; *see also* FIGS. 5-6). Likewise, Malino describes a calendar having a rectangular body portion 22 for display against a metal surface (e.g., against a refrigerator door). (*See* Malino, col. 3, lines 1-13; FIGS. 1-2.) Tate is a non-analogous reference that merely discloses an article of "golf clothing" having a magnetic material which is "concealed from view." (*See* Tate, col. 2, lines 6-29.)

Accordingly, even if there was a suggestion in the prior art to combine Abelarde, Tate, and Malino), the proposed combination would fail to teach or suggest all elements of independent claim 40 (as required under MPEP § 2143.03). For this reason alone, Applicants respectfully submit that independent claim 40 and associated dependent claims 41-43 are patentable over the prior art of record.

Second, unlike independent claim 40, Abelarde fails to disclose a storage compartment "sized to store the plurality of decorative ornaments." Rather, Abelarde discloses that the rectangular substrate 302 can have sunken recesses, each of which is sized to receive exactly one of the marker elements 328 for visual display from the front surface 302a (e.g., an individual square-shaped marker element can fit into a square-shaped recess). (*See* Abelarde, col. 5, lines 15-21; FIG. 6.) The Office Action did not contend that Malino or Tate disclosed a storage compartment as described in claim 40.

Yet again, even if there was a suggestion in the prior art to combine Abelarde, Tate, and Malino), the proposed combination would fail to teach or suggest all elements of independent claim 40 (as required under MPEP § 2143.03). For this reason alone, Applicants respectfully submit that independent claim 40 and associated dependent claims 41-43 are patentable over the prior art of record. Prompt allowance of claims 23-39 is respectfully requested.

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Applicants thank the Examiner for identifying the typographical error in our PTO Form 1449 that was submitted to the Office on January 31, 2006, and submits herewith a new PTO Form 1449 which correctly cites the Yu reference as D 458,407. Applicants respectfully request that the Examiner consider this reference and return an initialed copy of this PTO Form 1449.

No fee is believed to be due at this time. If necessary, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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